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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/615,780

07/10/2003

Noriyuki Nakanishi

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05/31/2007

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EXAMINER

CHANNAVAJALA, LAKSHMI SARADA

ART UNIT

PAPER NUMBER

1615

NOTIFICATION DATE

DELIVERY MODE

05/31/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/615,780	Applicant(s) NAKANISHI, NORIYUKI	
	Examiner Lakshmi S. Channavajjala	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/27/07</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of amendment, response and declaration dated 2-27-07 is acknowledged.

Claims 3-4 and 6-7 have been canceled. New claims 8-15 have been added.

Claims 1, 2, 5, and 8-15 are pending in the instant application.

Response to Arguments

Applicant's arguments see pages 6-9, filed 2-27-07, with respect to rejection of instant claims over the teachings of US 6,107,261 Taylor et al in view of JP 10-158696 have been fully considered and are persuasive. The rejection of claims over the above combination of references has been withdrawn.

However, in view of the prior art uncovered in a subsequent search, the following rejection has been applied to the instant claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Instant claim recites the limitation, "wherein the tert-butanol is added in an amount of 0.05 to 100 ppm based on the total weight of the composition", which is not supported by applicants' disclosure. A careful review of the instant specification reveals support for 0.01 to 1000 ppm, but not for the range of claim 8. In re Lukach, 442 F.2d 967, 169 USPQ 795 (CCPA 1971) (subgenus range was not supported by generic disclosure and specific example within the subgenus range); In re Smith, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) (a subgenus is not necessarily described by a genus encompassing it and a species upon which it reads).

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 5 and 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,075,025 to Wainberg et al (Wainberg) in view of US 6,107,261 to Taylor et al (Taylor) OR Wainberg and Taylor in view of US 5,705,467 to Choy OR Choy in view of Wainberg.

Instant claims 1, 2, and 12-15 are directed to a cosmetic composition comprising tert-butanol (0.01 to 1000 ppm) and at least one surfactant from the claimed group of surfactants.

Instant claims 5 and 8-11 are directed to a method for suppressing smell change or odor generation with passage of time in a cosmetic composition comprising tert-butanol (0.01 to 1000 ppm) and at least one surfactant from the claimed group of

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surfactants, wherein the method comprises adding t-butanol to the surfactant to suppress the smell generated by the surfactant.

Wainberg teaches disinfectant compositions comprising sodium hypochlorite and a tertiary aliphatic alcohol such as t-butanol for odor masking and also stabilizing sodium hypochlorite (abstract, C 1, L 27-39, L 51-67; c 2, L1-2; C 2, L 20-40). Wainberg also teaches addition of surfactants such as (fatty acid esters, polyoxyethylene or polyoxypropylene derivatives of fatty acid esters (lines bridging C2-C3). With respect to t-butanol, Wainberg teaches 0.2% to 60% by weight of t-butanol (C 3, L 40-52), as opposed to 0.01 to 1000 ppm (which translates to 0.0001 to 0.1% by weight). Wainberg does not teach the same surfactants claimed in the instant invention.

Taylor teaches antibacterial compositions containing an antimicrobial agent, a surfactant, a hydrotrope, hydric solvent and water. Among the surfactants, Taylor teaches alkyl ether sulfates that are ethoxylates (col. 3, lines 45-53 and col. 12), other surfactants such as items d, f, h, t, hh, qq etc (col. 17-18) and hydric solvents such as lower alcohols including n-butanol (col. 15, lines 23-33).

It would have been obvious for one of an ordinary skill in the art at the time of the instant invention to incorporate the surfactants of Taylor in the antibacterial composition of Wainberg because Taylor suggests that the surfactants increase the solubility of antimicrobial agent and also acts as a cleanser and foaming agent (C 6, L 38+ and C 11, L 57+ and example 4).

With respect to t-butanol, Wainberg teaches 0.2% to 60% by weight of t-butanol, as opposed to 0.01 to 1000 ppm (which translates to 0.0001 to 0.1% by weight).

However, the comparative data provided on page 8 of the instant specification shows that t-butanol is effective in suppressing smell at 0.5% as well as 0.05% (calculated based on the 0.1% aqueous solution of t-butanol employed in the compositions used). For claims directed to the composition, the limitation "which suppress the odor" is an intended use and hence carries no patentable weight. Further, Wainberg does teach t-butanol as an odor-masking agent and thus meets the limitation of suppressant.

For the claims directed to a method while Wainberg and Taylor do not teach the suppression of odor caused by surfactants, according to Wainberg t-butanol is an odor masking agent and the resulting combination from the teachings of the Wainberg and Taylor not only reduced the odor caused by chlorite of Wainberg, but also possesses the ability to reduce the odor caused by surfactants.

Alternatively, Choy teaches a cleaning composition comprising an alkyl ether sulfate surfactant as a thickening agent, a co-thickening surfactant, a solvent selected from terpene derivatives and tertiary alcohols and an electrolyte such as metal hypochlorite (abstract, C 3, L 7-19 and for the amounts of surfactants, solvents etc., see col. 2, L 59 – L67 & c 4, L 30-44). The formula of surfactant in col. 7, L 18-47 meets the claimed formula I. Choy teaches that tertiary alcohols tend to be bleach stable (c 3, L 49-54) and possess fragrance effect, some more desirable than other (c 7, L47-53). Among the tertiary alcohols, Choy teaches alcohols with 1-20 carbon atoms (C 8, L 24-34). It would have been obvious for one of an ordinary skill in the art at the time of the instant invention to choose t-butanol as a tertiary alcohol in the cleaning composition of Choy, in combination with surfactants, solvents, electrolyte etc., because Wainberg

suggests t-butanol possess odor-masking property and Choy recognizes that tertiary alcohols in general possess fragrance effect. Accordingly, a skilled artisan would have expected to achieve an odor masking as well as fragrance effect with 0.2% of t-butanol in the composition of Choy.

RESPONSE TO DECLARATION:

The declaration filed on 2-27-07, has been considered but not found persuasive. In view of the newly found prior art cited above. The example formulations compared in the declaration are directed to a shampoo comprising 9% sodium polyoxyethylene lauryl ether sulfate as the surfactant and 0.5 or 0.05 (0.1% or 10% aqueous solution of tert-butanol) that is equivalent to 5 ppm or 0.5 ppm. According to the declaration odor suppression is effective with 0.5 ppm, 5.0 ppm and 1000 ppm but a slightly inferior result was obtained with 2000 ppm and inferior with 5000 ppm. However, while the composition comprising 2000 ppm t-butanol only gave a slightly inferior result, it is unclear from the disclosure, claims or the declaration, whether the odor generation was tested immediately after preparing the composition and what is encompassed by the term "with passage of time". Is it days, weeks, months or years? Accordingly, the result "slightly inferior" does not accurately reflect the effect of t-butanol and is a relative term that varies with the passage of time. In addition, while the reference of Taylor (cited in the previous as well as this action) fails to recognize the odor suppressing property of t-butanol, the teachings of Wainberg and Choy in the newly made rejection above, do recognize the above property. Therefore, the argued unexpected result is not

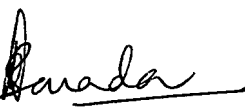
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unexpected in view of the newly cited prior art that teaches 0.2% (Wainberg) and 0.05% (Choy) of t-butanol, more so in view of the fact that the prior art recognizes t-butanol for the same effect i.e., odor masking, as in the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.00 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AU 1615
May 24, 2007


LAKSHMI S. CHANNAVAJJALA
PRIMARY EXAMINER